

REMARKS/ARGUMENTS

The election/restriction requirement dated April 3, 2007 has been considered. The Applicant hereby elects claims 1-32 and 63-106, identified by the Examiner as Invention I. The Applicant does not traverse the restriction requirement between Inventions I and II. The Applicant elects species 2B-4, on which claims 1, 2, 5, 6-20, 24-26, 28-36, 37, 38, 40-50, 52, 55-63, 65, 67-75, 77-80, and 97-106, are readable. The Applicant traverses the species restriction and election requirement.

The restrictions between Inventions I and II are based on product and process of use. Restriction between product and process of use is only proper if (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process. MPEP § 806.05(h).

In support of the restriction between Inventions I and II, the Office Action states that “the product [Invention I] as claimed can be used in a materially different process such as removing plaque [sic] or debris from blood vessel.” (Page 2). The Applicant notes the Examiner’s statement that subcutaneous tissue dissection is materially different than intravascular operation.

The Applicant reserves the right to prosecute the claims of Invention II in a divisional application.

The Office Action identified six distinct species: species of Figure 2A; species of Figures 2B-4; species of Figure 5; species of Figure 6; species of Figures 7 and 8; and species of Figures 9 and 10. As required, the Applicant herein identifies claims 1, 2, 5, 6-20, 24-26, 28-36, 37, 38, 40-50, 52, 55-63, 65, 67-75, 77-80, and 97-106 as being readable on Species II of Figures 2B-4.

Restriction between species is proper only if the species are mutually exclusive. MPEP § 806.04(f). The Examiner fails to explain why any of the identified 6 species would be mutually exclusive with respect to one another. The Applicant respectfully submits that all of the identified 6 species could be incorporated into a single embodiment and practiced simultaneously to dissect subcutaneous tissue.

For example, the same reference number “280” and accompanying description is used to designate the elongated dissecting member in each figure. Moreover, while the different

figures focus on different aspects and features of the elongated dissecting member 280, all of these features and aspects could be incorporated into a single embodiment. For example, all illustrated embodiments could incorporate the reservoir 270, pump 255, aspirant reservoir 270A, tubing 257, handle 260, and control 275, of the embodiment shown in Fig. 2A while all illustrated embodiments could additionally incorporate the valve 273 of the embodiment shown in Fig. 2B; all illustrated embodiments could incorporate the sheath 500 of the embodiment shown in a sectional view in Fig. 5; all illustrated embodiments could incorporate the hinges 770 of the embodiment shown in the plan view of Fig. 6; all illustrated embodiments could incorporate the lead lumen 650 shown in Figs. 7 and 8; and all illustrated embodiments could incorporate the manifold 920 shown in Figs. 9 and 10.

As such, the various aspects of the species identified by the Examiner could be incorporated into the same embodiment, clearly demonstrating that they are not mutually exclusive and not properly subject to a species restriction. MPEP § 806.04(f).

Furthermore, the Examiner has not met the burden under MPEP §808.01(a), §808.02 and §803 to provide reasons as to why the species election is required. “A requirement for restriction is permissible if there is a patentable difference between species as claimed.” See MPEP § 803 and § 808.02.” (MPEP § 808.01(a)) “Examiners must provide reasons and/or examples to support conclusions.” (MPEP §803).

The Examiner has not provided reasons or examples to support conclusions that the identified species are patentably distinct. The Applicant is directing arguments to the limited issue of the lack of proper grounds supporting the restriction of the Applicant’s claims for examination purposes. As such, the Applicant’s characterization of the claimed subject matter as it may pertain to the issue of distinctiveness or lack thereof within the context of restriction practice is not to be construed as an admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. § 103. Instead, the Applicant is merely addressing the Examiner’s clear omission of providing the explanation necessary to sustain a species restriction. (See MPEP §808.01(a); §808.02; and §803). As such, the Examiner’s species election and restriction requirement is deficient at least to the extent that it fails to provide reasons and/or examples of patentable differences between the species.

The Examiner contends that no claim appears generic to all of the above-identified species. A generic or genus claim is a claim that may include two or more of the disclosed embodiments within the breadth and scope of the definition of an invention. MPEP § 806.04(e).

The Applicant respectfully asserts that claim 1 is a generic claim to all of the species identified by the Examiner. Claim 1 reads on each of Figures 2A-10. As such, claim 1 is a generic claim to the species identified by the Examiner.

For these reasons, the Applicant respectfully request the Examiner to withdraw the restriction requirement as to the 6 identified species, and to proceed with examination of all pending claims of Invention I.

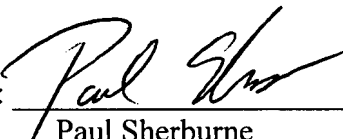
CONCLUSION

In view of the above, the Applicant respectfully requests reconsideration and withdrawal of the requirement for restriction. If the Examiner would find it helpful to discuss this issue by telephone, the Examiner is invited to contact the undersigned attorney.

Respectfully submitted,

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